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Application Number	09/972,741
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First Named Inventor	Allen
Group Art Unit	1636
Examiner Name	Qian, Celine X.
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ENCLOSURES *(check all that apply)*

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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Mariette A. Lapiz Reg. No. 44,202
Signature	Mariette A. Lapiz
Date	October 9, 2002

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Keith ALLEN

Group Art Unit: 1636

Serial No.: 09/972,741

Examiner: Qian, Celine X.

Filed: October 5, 2001

Attorney Docket No.: R-723-CIP

For: TRANSGENIC MICE CONTAINING MAGNESIUM-DEPENDENT PROTEIN PHOSPHATASE GENE DISRUPTIONS

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed September 9, 2002, concerning the Examiner's restriction to the claims, Applicants hereby provisionally elect, with traverse, the claims of Group I (claims 1-10, 17-23 and 45-52), drawn to a magnesium-dependent protein phosphatase targeting construct, a method of making said targeting construct, a cell comprising a disruption in a magnesium-dependent protein phosphatase gene, a non-human transgenic animal comprising a disruption in a magnesium-dependent protein phosphatase gene and a method of producing a transgenic mouse comprising a disruption in a magnesium-dependent protein phosphatase gene.

In the restriction, the Examiner asserts that claims 1-72 are drawn to twenty distinct subjects as follows: Group I (claims 1-10, 17-23 and 45-52), drawn to a targeting construct, a method of making the targeting construct, a non-human animal having a disruption in a magnesium-dependent protein phosphatase gene and a method of producing a transgenic mouse comprising a disruption in a magnesium-dependent protein phosphatase gene; Group II (claims 11 and 28-31), drawn to a method of identifying an agent that modulates the expression of a magnesium-dependent protein phosphatase gene by using a non-human transgenic animal having a disruption in the magnesium-dependent protein phosphatase gene; Group III (claims 12, 24-26 and 32-35), drawn to a method of identifying an agent that modulates the function of magnesium-

dependent protein phosphatase by using a non-human transgenic animal having a disruption in the magnesium-dependent protein phosphatase gene and a method of identifying an agent that modulates or ameliorates a lung abnormality by using a transgenic mouse having a disruption in the magnesium-dependent protein phosphatase gene; Group IV (claims 12, 27, 32 and 33), drawn to a method of identifying an agent that modulates the function of magnesium-dependent protein phosphatase by using a non-human transgenic animal having a disruption in the magnesium-dependent protein phosphatase gene and methods to identify agents that modulate white blood cell count by using a transgenic mouse having a disruption in the magnesium-dependent protein phosphatase gene; Group V (claims 12, 31 and 53-55), drawn to a method of identifying an agent that modulates the function of a magnesium-dependent protein phosphatase gene by using a non-human transgenic animal having a disruption in the magnesium-dependent protein phosphatase gene and methods of identifying agents that modulate anxiety by using a transgenic mouse having a disruption in a magnesium-dependent protein phosphatase gene; Group VI (claims 12, 32 and 69-71), drawn to a method of identifying an agent that modulates the function of a magnesium-dependent protein phosphatase gene by using a non-human transgenic animal having a disruption in the magnesium-dependent protein phosphatase gene and methods of identifying agents that reduce pain by using a transgenic mouse having a disruption in a magnesium-dependent protein phosphatase gene; Group VII (claims 13, 15 and 36-39), drawn to methods of identifying agents that modulate the expression of a magnesium-dependent protein phosphatase by using a cell having a disruption in the magnesium-dependent protein phosphatase gene; Group VIII (claims 14, 15 and 40-43), drawn to methods of identifying agents that modulate the function of a magnesium-dependent protein phosphatase by using a cell having a disruption in the magnesium-dependent protein phosphatase gene; Group IX (claim 16), drawn to an agent that modulates the function of a magnesium-dependent protein phosphatase gene; Group X (claim 16 and 44), drawn to an agent that modulates magnesium-dependent protein phosphatase gene expression; Group XI (claim 44) drawn to an agent that ameliorates a lung abnormality; Group XII (claim 44), drawn to an agent that reduces white blood cell count; Group XIII (claim 56), drawn to an agent that modulates anxiety; Group XIV (claim 57), drawn to a method of treating anxiety by administering a magnesium-dependent protein phosphatase expression modulating agent to a subject; Group XV (claims 57 and 58), drawn to a method of treating anxiety by

administering a magnesium-dependent protein phosphatase activity modulating agent to a subject; Group XVI (claims 59-65), drawn to a method of treating anxiety by administering a magenisium-dependent protein phosphatase; Group XVII (claims 62 and 66), drawn to a pharmaceutical composition comprising a magnesium-dependent protein phosphatase; Group XVIII (claims 67 and 68), drawn to a method of reducing pain by administering a magnesium-dependent protein phosphatase expression modulator to a subject; Group XIX (claims 67 and 68), drawn to a method of reducing pain by administering a magnesium-dependent protein phosphatase activity modulator to a subject; and Group XX (claim 72), drawn to an agent that reduces pain.

Specifically, the Examiner asserts that inventions of Groups I, IX-XIII, XVII and XX are patentably distinct from each other because they are drawn to materially distinct compositions that have differing modes of operation, function and effects. The Applicant disagrees with the Examiner's assertion in that the claims of Groups I, IX-XIII, XVII and XX are related and therefore would not require a separate search or examination that would seriously burden the Examiner.

The Examiner further asserts that the inventions of Groups II-VIII, XIV-XVI, XVIII and XIX are patentably distinct from each other because the inventions are drawn to methods that require different starting materials and modes of operation. The Applicant disagrees with the Examiner in that the claims of Groups II-VIII, XIV-XVI, XVIII and XIX are related and a search and examination of these claims can be made without serious burden on the Examiner.

The Examiner also asserts that the inventions of Groups I, IX-XIII, XVII and XX are patentably distinct from the inventions of Groups II-VIII, XVI, XVIII and XIX because the inventions are drawn to compositions and methods that are not directly related. The Applicant disagrees with the Examiner's assertion in that the inventions of Groups I, IX-XIII, XVII and XX are related to the inventions of Groups II-VIII, XVI, XVIII and XIX. Therefore, a separate search and examination of these claims is not necessary and can be made without serious burden on the Examiner.

Although the Applicant has provisionally elected Group I for purposes of advancing prosecution of the present application, Applicant contends, for the foregoing reasons, that the

restriction requirement is improper. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the requirement.

Respectfully submitted,

Date: Oct. 9, 2002

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Enclosures